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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,729	03/29/2001	Hironori Yahagi	826.1721	4351
21171 7590 07/19/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER PAULA, CESAR B	
			ART UNIT 2178	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

### Application No.

09/819,729

### Applicant(s)

YAHAGI, HIRONORI

### Examiner

CESAR B. PAULA

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/9/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This action is responsive to the appeal brief filed on 4/9/2007.

**This action is made Non-Final.**

2. Claims 1-14 remain pending in the case. Claims 1, 3, 9, 10, 11, 12, 13 and 14 are independent claims.
3. The rejections of claims 1, 9-11 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Brintzenhofe et al. (U.S. Pub. No. 20050223320; publication date October 6, 2005; filed May 31, 2005; continuation of application filed September 9, 1996) in view of Zeng et al. (U.S. Pub. No. 20020003906; publication date January 10, 2002; filed May 21, 2001; continuation of application filed September 22, 1998), have been withdrawn as necessitated by the Appellant's arguments.
4. The rejections of claim 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Brintzenhofe in view of Zeng in further view of DeRose (U.S. Patent 6105044; date of patent August 15, 2000; filed July 13, 1999) , have been withdrawn as necessitated by the Appellant's arguments.
5. The rejections of claims 3-4, 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Brintzenhofe in view of Zeng in further view of Ardoin et al. (U.S. Pub. No. 20020099684; publication date July 25, 2002; filed May 7, 2001; continuation

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of application filed December 13, 1999) , have been withdrawn as necessitated by the Appellant's arguments.

6. The rejections of claims 6-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Brintzenhofe in view of Zeng in further view of Ardoin in further in view of DeRose, have been withdrawn as necessitated by the Appellant's arguments.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites "*a searching device searching the structured document after being converted with the search key, extracting a character string corresponding to a position of a detected character string from contents of an element in a certain record when the character string corresponding to the search key is detected from contents of another element in the certain record,*" (lines 3-8). The Examiner was unable to find an explanation for converting the document using or with a search key. It was not found either in the specification, the extracting of a character string from one element when the character string corresponding to the search key is found in

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the contents of another element in the record. The specification does not show the extraction of a character string when the search key character is found somewhere else.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites "*a searching device searching the structured document after being converted with the search key, extracting a character string corresponding to a position of a detected character string from contents of an element in a certain record when the character string corresponding to the search key is detected from contents of another element in the certain record*," (lines 3-8). The Examiner was unable to find an explanation for converting the document using or with a search key. It's not clear what's meant by the extracting of a character string from one element when the character string corresponding to the search key is found in the contents of another element in the record. It's not understood how the extraction of a character string, takes place when the search key character is found somewhere else.

11. Claims 3-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites "a joining device" in lines 5-12. It is not clear which elements, and how they are being combined as synthesis targets.

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12. Claim 2 recites the limitation "the character string corresponding to the search key" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim. There is no previous instance of the character string related to the search key in the claim.

13. Claim 3 recites the limitation "the certain level" in lines 10-11. There is insufficient antecedent basis for this limitation in the claim. It is not clear which level this is making reference to—first or second combination certain levels.

14. Claim 7 recites the limitation "the synthesis target is lacking" in line 3. There is insufficient antecedent basis for this limitation in the claim. It is not clear what is lacking from the target.

***Claim Rejections - 35 USC § 101***

15. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 10 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 42, lines 11-14, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., computer-readable media, server, etc.) and intangible embodiments (e.g., propagation signal, program, and data). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

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To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the bottom, carrier medium and transmission media would be not statutory but storage media would be statutory.

***Claim Rejections - 35 USC § 102***

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1, 3-7, and 9-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanevsky (U.S. Pat. No. 6300947 B1; 10/9/2001; filed 7/6/1998).

**Regarding independent claim 1**, Kanevsky discloses the adaptation of HTML webpage documents, which contains hierarchical nested elements, such as text image, etc. (col.1, line 57-67, col.8, lines 16-34, fig. 6-7)-- *a document inputting device inputting information of a structured document that is written with a set of hierarchical elements, and composed of a plurality of records each including one text element or more.*

Furthermore, Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device (col.10, lines 36-65, fig.10-16). Textual data located about

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the same position, such as “YAHOO” and “News”, is combined to recreate a condensed version of the webpage with relatively the same position of two combined words, thereby decreasing the space occupied by the words--*a joining device generating a new text element by combining contents of text elements relatively at a same position among two records or more of the structured document or a generating device generating a new record that includes the new element and inherits a relative position relationship of elements in two records or more; a converting device converting the structured document by replacing the two records or more with the new record, thereby decreasing the number of hierarchical elements of the structured document.*

**Regarding independent claim 3,** Kanevsky discloses the adaptation of HTML webpage documents stored on a computer, which contains hierarchical nested elements, such as text image, etc. (col.1, line 57-67, col.8, lines 16-34, col.5, lines 20-67, fig. 6-7)-- *a document inputting device inputting information of a structured document written with a set of hierarchical elements; a storing device storing the information of the structured document;*

Furthermore, Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device (col.10, lines 36-65, col.11, lines 1-67, col.15, lines 1-36, fig. 7, 10-16). One textual data is located below another piece of text, such as “Business” and “Technology”; these words are combined to create a condensed version of the webpage with relatively the same position of two combined words. Unnecessary data is removed from the output document, thereby decreasing the space occupied by the words. Other words located down the first line of the document where joined words are, are copied exactly, such as “World”,



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*“Health” (1502, fig.13)-- a joining device generating a plurality of new text elements by combining, as synthesis targets, content of each element included in a first combination of elements that successively exist side by side in a level immediately below a certain element and have a same element name, and content of each element included in a second combination of elements that have a same element name in a certain level lower than the elements of the first combination, elements in each level on a route from the elements of the first combination to the certain level having a same element name, in the structured document to preserve a text relationship between the contents; a generating device generating a synthesized substructure that includes the plurality of new text elements, and inherits a relative position relationship of original elements among the plurality of new text elements; a duplicating device generating a duplication of an unjoined element below a new element included in a synthesized substructure generated from an element higher than the unjoined element; a deleting device deleting an unnecessary original element; a converting device converting the structured document into a structured document of a synthetic type configured by a synthesized substructure by using said joining device, said generating device, said duplicating device, and said deleting device, thereby decreasing the number of hierarchical elements of the structured document; and a document outputting device outputting the structured document of the synthetic type.*

**Regarding dependent claim 4,** Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device (col.10, lines 36-65, col.15, lines 1-36, fig. 7, 10-16). One textual data is located below another piece of text, such as “Business” and “Technology”; these words are combined to create a condensed version of the webpage with

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relatively the same position of two combined words, in a case where the words are not combined by reside separately--*generating the synthesized substructure if a combination of elements that successively exist side by side and have a same element name in two levels or more on the route to the certain level is not found.*

**Regarding dependent claim 5**, Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device (col.10, lines 36-65, col.11, lines 1-67, fig. 7, 10-16). Elements, such as links, icons, etc. are separated into groups, and then combined based on the size of the group to be combined.

**Regarding dependent claim 6**, Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device, by combining words using characters, such as "&" (col.10, lines 36-65, col.11, lines 1-67, col.15, lines 1-36, fig. 13). -- *generating contents of the new elements by inserting a delimiter between the two joined contents.*

**Regarding dependent claim 7**, Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device, by combining words using characters, such as "&" (col.10, lines 36-65, col.11, lines 1-67, col.15, lines 1-36, fig. 7, 13). In other words, when the words are combined the character is added where it is not found to indicated relatedness to the same group -- *consecutively inserting the delimiter in the contents of new elements if content of an element which becomes the synthesis target is lacking.*

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**Regarding independent claims 9, 10, 11 and 14**, the claims reflect the computer-readable storage medium on which is recorded a program, a propagation signal for propagating a program, a converting apparatus and a method for performing the operations of claim 1 and are rejected along the same rationale.

**Regarding independent claims 12 and 13**, the claims reflect the methods for performing the operations of claim 3 and are rejected along the same rationale.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claim 2, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of DeRose (U.S. Patent 6105044; date of patent August 15, 2000; filed July 13, 1999).

This rejection is made in light of the 35 USC 112 1<sup>st</sup>, and 2<sup>nd</sup> rejections above.

**Regarding dependent claim 2**, Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device, by combining words using characters, such as "&" (col.10, lines 36-65, col.11, lines 1-67, col.15, lines 1-36, fig. 13). Kanevsky does not disclose *a key inputting device inputting a search key or searching device searching the*

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*structured document after being converted with the search key, extracting a character string corresponding to a position of a detected character string from contents of an element in a certain record when the character string corresponding to the search key is detected from contents of another element in the certain record, restoring a record before being converted, which includes the search key, from the detected character string and the extracted character string, and outputting the restored record as a search result.* DeRose teaches inputting a search key (col. 13, lines 34-37; col. 15, lines 29-35) and searching the document, extracting a string corresponding to a position of a detected string from contents of an element in a certain record when the string corresponding to the search key is detected from contents of another element in the certain record, restoring a record from the detected character string and the extracted character string, and outputting the restored record as a search result (col. 13, lines 34-37, 47-67; col. 14, lines 1-48; col. 17, lines 60-62). It would have been obvious to one of ordinary skill in the art, having the teachings of Kanevsky and DeRose before him at the time the invention was made, to modify document conversion as taught by Kanevsky to include search keys as taught by DeRose, because of all the reasons taught by DeRose, including to allow users to navigate readily an electronic document and to manipulate such document in an efficient manner (col.2, lines 35-67).

**Regarding dependent claim 8,** Kanevsky discloses generating a stripped version of the webpage, to be displayed on a smaller screen device, by combining words using characters, such as "&" (col.10, lines 36-65, col.11, lines 1-67, col.15, lines 1-36, fig. 13). Kanevsky does not disclose *a key inputting device inputting a search key or a searching device comparing a*

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*character string between two delimiters, which is included in contents of elements within the structured document of the synthetic type, with a character string of the search key, obtaining an order of a delimiter preceding a character string corresponding to the search key when the character string corresponding to the search key is detected from contents of elements within a certain synthesized substructure, extracting a character string between a delimiter corresponding to the order and a next delimiter in contents of another element in the certain synthesized substructure, restoring a corresponding portion of the structured document before being converted from the detected character string and the extracted character string, and outputting the restored portion as a search result.* DeRose teaches inputting a search key (col. 13, lines 34-37; col. 15, lines 29-35) and comparing a string between two delimiters with a string of the search key, obtaining an order of a delimiter preceding a string corresponding to the search key when the string corresponding to the search key is detected, extracting a string between a delimiter corresponding to the order and a next delimiter(word tag) in contents of another element (the end document tag)in the substructure, restoring a corresponding portion of the structured document before being converted from the detected and extracted strings, and outputting the restored portion as a search result (col. 13, lines 34-37, 47-67; col. 14, lines 1-48; col. 17, lines 60-62; col. 18, lines 60-62). It would have been obvious to one of ordinary skill in the art, having the teachings of Kanevsky and DeRose before him at the time the invention was made, to modify document conversion as taught by Kanevsky to include search keys and delimiters as taught by DeRose, because of all the reasons taught by DeRose, including to allow users to navigate readily an electronic document and to manipulate such document in an efficient manner (col.2, lines 35-67).

***Response to Arguments***

8. Applicant's arguments regarding claims 1, and 3, filed 4/9/2007 have been fully considered but they moot in light of the newly applied prior art rejections.

Claims 2 and 4-8 depend from independent claims 1 and 3. Therefore claims 2 and 4-8 are rejected at least based on the rationale of the rejection above.

***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hill et al. (Pat. # 6,023,714 A ), DeRose et al. (Pat. # 6,546,406 B1, and 6,167,409 A), Rheume (Pat. # 6,247,018 B1), and Jakopac et al. (Pat. # 2002/0029229 A1).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.


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Any response to this Action should be mailed to:  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)

  
**CESAR PAULA**  
**PRIMARY EXAMINER**  
7/17/2007